



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Michael J. Heller et al.

Serial No.: 09/128,718

Filed: August 3, 1998

For: Methods and Apparatus for Electronic
Synthesis of Molecular Structures (as
amended herein)

Group Art Unit: 1631

Examiner: Marschel

TECH CENTER 1600/2900

Patent
236,662
02 2001

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Plunkett
10/17/02

10/02/2001 MWOLDER1 00000029 122475 09128718

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TERMINAL DISCLAIMER

Commissioner for Patents
Washington, D.C. 20231

Sir:

I, David B. Murphy, represent that I am an attorney of record for the above-identified application. NANOGEN, INC. (hereinafter referred to as "NANOGEN") is the owner of 100% interest in the above-identified invention by virtue of assignment from the inventor in the parent application, U.S. Application Serial No. 08/146,504, filed November 1, 1993, now U.S. Patent No. 5,605,662. The assignment from the inventors to NANOGEN was recorded in the Patent and Trademark Office on February 23, 1994, on Reel 6898, Frame 421-424.

NANOGEN hereby disclaims the terminal part of any patent granted on the above-identified application which would extend beyond the expiration date of U.S. Patent No. 5,929,208. Moreover, NANOGEN hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the

OC-92666.1

CERTIFICATE OF MAILING
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

September 24, 2001
Date of Deposit

Denise Doss

Name of Person Mailing Paper

Signature of Person Mailing Paper

legal title to U.S. Patent No. 5,929,208, this agreement to run with any patent granted on the above-identified application and to be binding upon NANOGEN, its successor, or assigns.

NANOGEN does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term of U.S. Patent No. 5,929,208 in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.312(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Enclosed is our check in payment for the requisite fee of \$110.00. If any additional fees are necessitated by the filing of this document, please charge Deposit Account No. 12-2475.

Respectfully submitted,

LYON & LYON LLP

Dated: September 24, 2001

By: 

David B. Murphy
Reg. No. 31,125

DBM/dnd
633 West Fifth Street, Suite 4700
Los Angeles, California 90071-2066
(949) 567-2300 or (213) 489-1600

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 10/17/02

APPL. S.N.: 09/128,718

TO EXAMINER: MARStahel

ART UNIT: 1631

ROOM _____

MAILROOM DATE 9/28/02

AFTER FINAL YES _____ NO ☒ NUMBER OF T.D(S). FILED 2

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claim(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl, or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)